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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,749	08/28/2001	James H. Lie	0325.00503	5761

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EXAMINER

THOMPSON, ANNETTE M

ART UNIT

PAPER NUMBER

2825

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/940,749

Applicant(s)

LIE, JAMES H.

Examiner

A. M. Thompson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached Action and Response to Remarks.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4, 6-11 and 13-20.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

A. M. Thompson
Primary Examiner
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Continuation of 3. Applicant's reply has overcome the following rejection(s): The 35 U.S.C. 112, second paragraph rejection regarding the antecedent basis of "said superset pinout".

DETAILED ACTION

Claim 12 is cancelled by the instant after-final amendment that has been entered.

Claim Objections

1. Claim 9 is objected to because of the following informalities: Pursuant to claim 9, at line 3, change "to" to -for--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Pursuant to claim 1, the relation between *eliminating footprint variations* and the remainder of the claim 1. Footprint variations cannot be eliminated where there is first no prior recitation of their creation. Pursuant to claim 19, the relation between *layout variations* and the rest of the claim is unclear. Layout variations cannot be eliminated where there is no prior recitation of their creation. Additionally, "said superset pinout" lacks prior antecedent basis. Pursuant to claim 20, the relation between layout and footprint changes and the rest of the claim is unclear. Layout and footprint changes cannot be reduced where there is first no prior recitation of their existence. Pursuant to claim 3, Applicant fails to set forth the subject matter that Applicant claims as his invention.

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4. Pursuant to claim 10, it is unclear to what late changes will be allowed; furthermore "without external components" is a dangling phrase and seem unrelated to the rest of the claim. Pursuant to claim 12, the step of initiating is unclear within the context of the claim; i.e. what pins are being initiated and where is this occurring.

Response to Remarks

5. Examiner granted an after-final interview on the instant application to Mr. Christopher Maiorana, Applicant's representative, on or about February 25, 2004 because Examiner was convinced that disposal of the instant application could be accomplished therein. The claim amendments required more than nominal reconsideration. Nevertheless, based on the final Office action, Examiner spent almost two hours assisting Applicant's representative in amending the claim language of the application and providing suggestions of possible claim cancellations and restructuring. However, despite this expenditure of time, the application is still not in a condition for allowance. Although Applicant's representatives further consulted with a supervisory examiner regarding additional claim amendments for the instant application, the claims are still not in a condition for allowance. Based on the foregoing prosecution history, Examiner is not convinced that further after-final interviews will expedite the disposal of the instant application or even clarify issues for appeal.

Conclusion

6. Any inquiry concerning this communication or earlier communications should be directed to Examiner A.M. Thompson whose telephone number is (571) 272-1909. The Examiner can usually be reached Monday thru Friday from 8:00 a.m. to 4:30 p.m. If

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attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Matthew S. Smith, can be reached on (571) 272-1907.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562 or the Customer Service Center whose telephone number is (571) 272-1750.

7. Responses to this action should be mailed to the appropriate mail stop:

Mail Stop _____

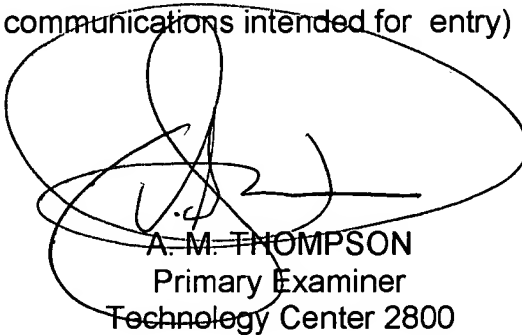
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or faxed to:

(703) 872-9306, (for all **OFFICIAL** communications intended for entry)



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